

Appl No.: 10/646,480

Atty. Dkt.
PC-1419**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 2 canceled claims 3, 4, 11, 12, 17-20 and added new claims 21-24. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

Claim 1 has been amended to clarify the invention having a molded top handle, right handle and left handle, and a plurality of longitudinal indentations in the flat side of the container for strength and reinforcement that are described in reference to component labeled 21, 24, 27 and 65 in Figures 1-5 of the subject invention. Claim 2 has been amended to clarify the novel triangular configuration of the molded top handle, right handle and left handle. New claim 21 has been added to clarify that the flat side has at least three longitudinal indentations for strength and reinforcement. Claim 22 has been added to include the novel longitudinal indentations in the rounded sidewalls of the container for strength and reinforcement, with claim 23 specifying an indentation behind each one of the three handles. New independent claim 24 is a combination of claims 1, 2, 6, 7, 8, 21, 22 and 23, where the entire container is formed from molded plastic.

As to the election requirement, applicant has now canceled claims 17-20 and reserves the right to file a divisional application in the future.

Claims 2-3 were rejected under sec. 112 as being indefinite. Claim 3 has been cancelled, and claim 2 has been accordingly amended to clarify the triangular configuration of the three handles. Removal of this rejection is respectfully requested.

Claim 11 was objected to and is now canceled.

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Claims 1-6, 8, 10-11 and 15 were rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183. Worsell has a single "riveted" type top handle 15 along the front and rear ends of the container, and Leatherman has a pair of slots in a top portion of the container.

None of these references includes the novel three handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

Additionally, the novel features of claims 7, 9, 13, 14 and 21-24 are not described or taught by these references.

Applicant further disagrees with the examiner's comments regarding claim 8 being an "optimum value of a resultroutine skill in the art." The examiner is not allowed to reject claimed features based on personal feelings. Under the MPEP rules, an examiner must cite references to reject claimed features or must remove the rejection for at least these reasons alone.

Arguably, it might be "obvious to try" to test various dimensions for this invention. However, Examiner is well aware that "obvious to try" is not the standard for determining inventiveness. See also *In re Kaplan*, 789 F. 2d at 1580, 229 U.S.P.Q. at 683, where the court held: "In effect, what the Board did was to use a disclosure of appellants' own joint invention which had been incorporated in the Kaplan sole disclosure to show that their invention was but an obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not a 1-year time bar, as prior art against him. That is impermissible."

Thus, removal of this rejection over these references is respectfully requested.

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Claims 7 and 9 were rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183 and in view of Ditzik. This latter reference does not overcome the deficiencies to Worsell and Leatherman. Ditzik attaches a "plastic bag" to a "triangular frame", abstract, and has nothing to do with a plastic totally molded refuse container.

Ditzik does not describe, teach or suggest the novel three handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

Additionally, the novel features of claims 7, 8, 9, 13, 14 and 21-24 are not described or taught by these references. Thus, removal of this rejection combination is respectfully requested.

Claim 12 was rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183 and in view of Frysinger '458. This latter reference does not overcome the deficiencies to Worsell and Leatherman. Frysinger describes a "thermally insulated container", title, which is nonanalogous prior art, having nothing to do with a plastic totally molded refuse container.

Frysinger shows a rectangular box having a rectangular open end which is structurally different from the D-shaped open end of the subject claims. Frysinger requires the use of separately fastened on hinged handle loops 42.

Frysinger does not describe, teach or suggest the novel three molded on handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

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Additionally, the novel features of claims 7, 8, 9, 13, 14 and 21-24 are not described or taught by these references. Thus, removal of this rejection combination is respectfully requested.

Claim 13 was rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183 and in view of Glomski. This latter reference does not overcome the deficiencies to Worsell and Leatherman. Glomski does not describe, teach or suggest the novel three handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

Additionally, the novel features of claims 7, 8, 9, 13, 14 and 21-24 are not described or taught by these references. Thus, removal of this rejection combination is respectfully requested.

Claim 14 was rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183 and in view of Grimes '144. This latter reference does not overcome the deficiencies to Worsell and Leatherman. Grimes describes a "garbage can with a removable bottom", title and has nothing to do with a plastic totally molded refuse container with a closed bottom.

Grimes does not describe, teach or suggest the novel three handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

Additionally, the novel features of claims 7, 8, 9, 13, 14 and 21-24 are not described or taught by these references. Thus, removal of this rejection combination is respectfully requested.

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Claim 16 rejected under sec. 103 as being unpatentable over Worsell '305 in view of Leatherman '183 and in view of Haas. This latter reference does not overcome the deficiencies to Worsell and Leatherman. Haas is structurally different from the subject invention and has no D-shaped open end.

Haas does not describe, teach or suggest the novel three handles and the flat side strengthening and reinforcement indentations specified in the amended claim 1 and the triangular configuration of the three handles specified in claims 2 and 24.

Additionally, the novel features of claims 7, 8, 9, 13, 14 and 21-24 are not described or taught by these references. Thus, removal of this rejection combination is respectfully requested.

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vacck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

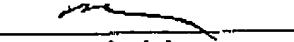
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Applicant contends the references cannot be modified to incorporate the features of subject claims 1, 2, 5-10, 13-16 and 21-24 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1, 2, 5-10, 13-16 and 21-24 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;



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